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25006 7590 05/08/2008 GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			EXAMINER CHAWAN, VIJAY B	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY H. SCHWAB and JOHN G. POSA

Appeal 2007-3707
Application 09/877,628
Technology Center 2600

Decided: May 8, 2008

Before ROBERT E. NAPPI, CARLA M. KRIVAK, and KEVIN F.
TURNER, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 and 6.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Claim 2 was canceled by the Amendment filed March 1, 2005, claims 3 and 4 were cancelled by the Amendment filed April 18, 2006, and claim 5 was cancelled by the Amendment After Final filed December 18, 2006.

STATEMENT OF CASE

Appellants' claimed invention is a method of enhancing electronic communications. The method includes storing enhancement information at the location of the recipient (cl. 1; Spec. 1:16-12; Spec. 2:1-3; Spec. 3:10-16).

Independent claims 1 and 6, the only claims on record in this appeal, are reproduced below.

1. A method of enhancing an electronic communication, comprising the steps of:

transmitting and receiving a message or file having a content; and

storing, at the location of a recipient, enhancement information enabling the recipient to visualize the sender.

6. A method of enhancing an electronic communication, comprising the steps of:

transmitting and receiving a message or file having a content; and

storing, at the location of a recipient, -phonemes enabling the recipient to listen to the content in a synthesized voice of the sender.

REFERENCES

Gaspar	US 5,111,409	May 5, 1992
Tullis	US 5,802,314	Sep. 1, 1998
Spies	US 6,035,273	Mar. 7, 2000

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) based upon the teachings of Tullis and Gasper. The Examiner rejected claim 6 under 35 U.S.C. § 103(a) based upon the teachings of Tullis and Spies.

Appellants contend that neither Tullis nor Spies teach or suggest storing enhancement information at the location of a recipient (Br. 2).

ISSUES

Did the Examiner err in rejecting claim 1 under 35 U.S.C. §103(a) as obvious over Tullis and Gasper? Did the Examiner err in rejecting claim 6 under 35 U.S.C. §103(a) as obvious over Tullis and Spies?

FINDINGS OF FACT

1. Appellants' invention allows storing of enhancement information at the location of the recipient. This enables the recipient of the message or file to more fully appreciate the content, including visualizing the sender (Br. 2; cl. 1).

2. Appellants' invention also allows storing of phonemes at the location of the recipient. This enables the recipient to listen to the content in a synthesized voice of the sender (Br. 2; cl. 6).

3. Appellants define enhancement information as “‘helper information,’ which enhances the value of the original file” (Spec. 2:17).

4. The helper information can include phonemes, image information, etc. (Spec. 2:18-20; Spec. 3:1-21).

5. A phoneme is defined as “(noun) [T]he smallest phonetic unit in a language that is capable of conveying a distinction in meaning, as the *m* of *mat* and the *b* of *bat* in English. ETYMOLOGY: French *phonème*, from

Greek *phōnēma*, *phōnēmat-*, utterance, sound produced, from *phōnein*, to produce a sound, from *phōnē*, sound, voice.” The American Heritage Dictionary of the English Language, Houghton Mifflin Co. (4th ed. 2000).

6. Tullis teaches a method and apparatus for sending and receiving multimedia messages. The user has a database that contains all address information on individuals with whom the user communicates and contains all pertinent information related to those individuals such as telephone numbers, facsimile numbers, and email addresses (col. 2, ll. 51-60).

7. Gasper teaches a hyperanimator system (col. 5, ll. 14-18). This allows a user to create and control animated lip-synchronized images or objects by using a personal computer (Spec. 2:51-55). The system provides the capability of using both synthetic speech and/or digitized recording to provide speech to synthesized actors (synactors) (col. 3, ll. 41-43).

8. Spies teaches a speaker specific speech-to-text/text-to-speech communication system. Spies include speech compression and transmission devices (CTDs). The text is transmitted from a speaking party’s device to a listening party’s device where it is converted back to speech using the speaking party’s speech profile (Abstract). The speech profiles of both parties are stored at both CTDs (col. 2, ll. 15-27).

PRINCIPLES OF LAW

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), stated that three factual inquiries underpin any determination of obviousness:

Under § 103, [1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved. Against this background, the

obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Id. at 17-18

Where the claimed subject matter involves more than the simple substitution one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness must be based on “an apparent reason to combine the known elements in the fashion claimed.” *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007). That is, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Such reasoning can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Rejection of Claim 1 as Obvious over Tullis and Gasper

The Examiner finds that Tullis teaches all the features of claim 1 except for storing enhancement information enabling the recipient to visualize the sender (Ans.4). The Examiner also finds that Gasper teaches storing audio information as well as video information and thus it would be obvious to one of ordinary skill in the art to store the image information taught by Gasper in Tullis's method of transmitting audio information (Ans. 4). As noted in Findings of Fact 6 (FF), Tullis teaches a user database that contains all pertinent information related to the user, but does not teach storing enhancement information enabling the recipient to visualize the sender. Gasper teaches a hyperanimator system that allows a user to create and control animated lip-synchronized images (FF 7). As expressed in *KSR, supra.*, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In the present instance, the Examiner has not stated why these unrelated references should be combined other than alleging that the combination would result in a method that would "advantageously store at the location of the recipient audio message along with the corresponding video information, because this would enable the recipient to recall at a future date the message according to user's preference." (Ans 4) There is no indication in either of these references, and none indicated by the Examiner, of the relevance of combining these two references. Gasper does not suggest providing enhancement information enabling the recipient to visualize the sender (cl. 1). Gasper merely allows a user of a personal computer to develop synactors

(synthesized characters/animation). The Examiner has not provided a rational explanation for combining these references. *KSR, supra*.

The Examiner has also not made the factual determinations set forth in *Graham v. John Deere, supra*, and thus has not presented a prima facie case of unpatentability.

Rejection of Claim 6 as Obvious over Tullis and Spies

The Examiner stated that Tullis teaches all the features of claim 6 except for storing phonemes at the location of the recipient, enabling the recipient to listen to the content in a synthesized voice of the sender. The Examiner then states that Spies teaches the recipient is “able to listen to the content of the message in sender’s voice” (Ans. 4) by using phonemes (Ans. 5). Appellants urged that there is no mention of phonemes in Spies or Tullis. The Examiner countered that “phonemes are basic units of speech...” (Ans. 5).

As set forth in FF 5, a phoneme is a basic unit of speech. Spies teaches a speech-to-text/text-to-speech system (FF 8) such as the Dragon System or IBM’s VoiceType Dictation (col. 3, ll. 59-61). These systems use stored speech profiles to determine the best acoustic word match for any spoken word (col. 3, ll. 62-67). It is well known by those skilled in the art that these compression and transmission devices (CTDs) use stored speech profiles employing phonemes-as they are basic distinctive units of speech.

Thus, we are not persuaded by the Appellants’ arguments that Spies does not teach phonemes. Accordingly, Appellants have not convinced us of error in the Examiner’s rejection of claim 6.

CONCLUSION

We therefore conclude that the Examiner did err in rejecting claim 1 under 35 U.S.C. § 103(a) and that the Examiner did not err in rejecting claim 6 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner rejecting claims 1 and 6 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED-IN-PART

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